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EXAMINER				
HUPCZEY, JR, RONALD JAMES				
ART UNIT		PAPER NUMBER		
4116				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/528,841

Applicant(s)

NESSLER, NORBERT

Examiner

RONALD J. HUPCZEY, JR.

Art Unit

4116

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-20 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13 is/are rejected.
- 7) ☒ Claim(s) 7-12 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 5/27/2005, 5/27/2005, 5/27/2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Preliminary Amendment

1. In regard to the communication filed on March 3rd, 2005, claims 1 – 20 are pending.

Specification

2. As currently written, the specification lacks a brief description of figures 1 - 6 and the subsequent inclusion of a detailed description of the figures as required by 37 CFR 1.77(b). Examiner recommends for applicant to review the requirements for the specification and amend as needed in order to be within the rules of 37 CFR 1.77(b). Such corrections will add to the clarity of the disclosure and allow for a better understanding of the subject matter which the applicant intends to claim.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(u) (1) because the figure appearing at the top of the drawing page (5/8), is lacking a view number. 37 CFR 1.84(u) (1) states: The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Regarding claim 14, the recitation therein contains method-like language contained within an apparatus claim. Examiner notes that for the purposes of examination, this language fails to further structurally limit the apparatus defined and will be interpreted solely as a statement of intended use. Furthermore, claim 14 provides for the use of "... monitoring the neutral electrode contact quality monitoring circuit of an electrosurgical device.", but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1-5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nessler et al ("Testing Device for Surgical Grounding Plates") in view of Pethig ("Dielectric Properties of Biological Materials: Biophysical and Medical Applications").

Regarding claims 1 and 2, Nessler et al discloses a device for testing a neutral electrode containing a measuring surface (gold-plated surface, pg. 2388) formed from a plurality of electrodes (1 cm² squares, pg. 2388). Nessler et al further discloses the measuring electrode to be

connected to an equivalent resistance circuit (measuring resistance, pg. 2388) containing at least two resistances. Additionally, Nessler et al discloses the equivalent resistance circuit in thermal contact with a temperature sensor (thermo-sensors, pg. 2389). Nessler et al fails to disclose for one resistance of the equivalent resistance circuit to be formed by a reactive resistance. Pethig discloses an electric equivalent model of human skin formed by two resistors and one capacitor (see figure 9, pg. 465, left column, 1st paragraph). Pethig further discloses the need to model the capacitance found in various tests conducted throughout the reference. Therefore, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to include some reactive resistance element (i.e. capacitor) within the equivalent resistance network to better model an equivalent electronic skin model. The combination is supported by the research provided by Pethig and the various references included within the document to provide a representative of capacitance with any electronic model of the human skin.

Regarding claim 3, Nessler et al discloses fails to disclose the resistance any of the equivalent resistance circuit to be formed by reactive resistance. Pethig discloses the inclusion of a capacitor in an equivalent electronic skin model (see figure 9, pg. 465, left column, 1st paragraph). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a reactive resistance circuit (i.e. capacitor) as the equivalent resistance circuit to allow for more accurate equivalent electronic skin model. The combination is supported by the findings of Pethig on the capacitance of human skin and the old and well known methods of constructing electronic circuits.

Regarding claim 4, Nessler et al discloses the device connectable to an alternating voltage source (Technical Data, pg. 2388) and for the voltage source to have a variable frequency (Technical Data, pg. 2388).

Regarding claim 5, Nessler et al discloses the measuring electrodes to be arranged in a matrix form of columns and rows (1 cm^2 squares, pg. 2388 and see figure 1).

Regarding claim 13, Nessler et al discloses the temperature sensor to be in thermal contact with the equivalent resistance circuit and formed from transistors (thermo-sensors, pg. 2389).

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nessler et al ("Testing Device for Surgical Grounding Plates") in view of Pethig ("Dielectric Properties of Biological Materials: Biophysical and Medical Applications") and further in view of Nessler et al ("The Neutral Electrode in Electrosurgery, A Risk For The Patient?").

Regarding claim 6, Nessler et al ("Testing ...") discloses a device to contain an equivalent resistance circuit. Nessler et al ("Testing ...") fails to disclose any specific structure related to the equivalent resistance circuit. Nessler et al ("The Neutral ...") discloses an equivalent resistance circuit containing a central node connected to one terminal of four horizontal resistances (R_h) and one terminal to each a first and second vertical resistance (R_v) (see figures 5 and 6). Nessler et al ("The Neutral ...") further discloses the opposite ends of the horizontal equivalent resistances to be connected to other horizontal resistances in the network and for one vertical equivalent resistance to be connected to the electrode (see figures 5 and 6). Additionally, Nessler et al ("The Neutral ...") discloses a second vertical equivalent resistance to be connected to ground (see figures 5 and 6). Therefore it would have been obvious to one of

ordinary skill in the art at the time of the invention to include the equivalent resistance circuit model of Nessler et al ("The Neutral ...") with the general device disclosed in Nessler et al ("Testing ...") to allow for a device with a equivalent resistance circuit representing the multiple layers of human skin. Both devices are directed toward the same field of invention and current techniques in circuit construction readily allows for such a network to be utilized.

Allowable Subject Matter

10. Claims 7-12, 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 15 - 20 are allowed.

12. The following is an examiner's statement of reasons for allowance:

Regarding claims 7 – 10, none of the prior art of record recites peripheral equivalent resistance circuits attached to impedance circuits or any structure related to the peripheral impedance circuits.

Regarding claims 11 and 12, none of the prior art of record recites further limitations on the horizontal equivalent resistance such as its location outside the measuring range of the temperature sensor.

Regarding claim 14, none of the prior art of record recites the device having the use of monitoring the neutral electrode contact quality circuit of an electrosurgical apparatus it is associated with.

Regarding claims 15 – 20, none of the prior art found shows the structure as claimed for a device for testing a neutral electrode. Distinguishable from the prior art is the claimed structure relating to the construction of the device such as the measuring circuit board, drilled circuit board, through holes and etc.

13. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RONALD J. HUPCZEY, JR. whose telephone number is (571)270-5534. The examiner can normally be reached on Monday through Friday (7:30 A.M. to 5:00 P.M. EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe H. Cheng can be reached on 571-272-4433. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. H./
Examiner, Art Unit 4116

RJH
/Jefferey F Harold/
Supervisory Patent Examiner, Art Unit 4113